

## **REMARKS**

The above amendments and these remarks are responsive to the Office action dated September 22, 2004. Claims 1-13 are pending in the application. Claims 1-13 are rejected. By way of the present amendment, claim 13 is cancelled and claims 1, 2, 7-10, and 12 are amended. In view of the amendments above, and the remarks below, Applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

### **Objections to the Drawings**

The drawings were objected to as indefinite on the basis that it was unclear what component reference numeral 40, as shown between Figures 1 and 2, was referring to. Applicant has amended Figure 1 of the drawings, adding a lead line to reference numeral 40 and clearly indicating that reference numeral 40 refers to the base of container 3, as described in the specification at page 6, lines 7-10, and as shown in Fig. 2. Figs. 1 and 2 are definite and comply with the standards of 37 C.F.R. § 1.84. Therefore, Applicant respectfully requests with withdrawal of the objection to the drawings.

### **Rejection Under 35 U.S.C. § 112**

Claim 7 stands rejected under 35 U.S.C. § 112 on the basis that the recited element “the pair of plates” do not have sufficient antecedent basis. Applicant has amended claim 7 to recite “in which said offset rollers are supported by a pair of plates on opposing sides of the post” so as to positively introduce the first occurrence of the objected-to

expression. Support for the amendment may be found generally in the specification as filed, and more particularly at page 4, line 16 to page 5, line 2, and in Fig. 3.

In view of the amendment to claim 7, Applicant suggests that the claim both definitely and particularly recites the claimed subject matter, and request the withdrawal of the rejection under 35 U.S.C. § 112.

### **Objections Under 35 U.S.C. § 102**

Claims 1-5 and 9 stand rejected under 35 U.S.C. § 102 in view of U.S. Patent No. 5,489,182 to Habicht. The standard for an anticipation rejection under 35 U.S.C. § 102 has been well established by the Court of Appeals for the Federal Circuit, and is set forth in M.P.E.P. paragraph 2131, which provides that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. In addition, the identical invention must be shown in as complete detail as is contained in the claim. For a prior art reference to anticipate a claimed invention, every element of the claimed invention must be identically shown in a single reference, and these elements must be arranged as in the claim under review.

Claim 1, as presently amended, recites “a storage portion” as well as “a carriage connected to the storage portion and moveable with respect to the support structure to remove the storage portion between a loading position and a storage position”. Habicht does not disclose a storage portion. Habicht includes a container 48 or 28, however the container of Habicht also includes a funnel shaped bottom and a valve discharge port so as to allow “charging or discharging” of the container as described in Habicht at column

4. Accordingly, the container of Habicht is not adapted to provide storage but rather to provide for the discharging of a fluent material from the container. Because of this, the container of Habicht may not be located at a storage position as the purpose of the container of Habicht is not to store objects. In view of the foregoing comments, Applicant respectfully requests that the Examiner's anticipation objection to claim 1 be withdrawn.

Claims 2 to 5 and 9 derive patentable significance from their ultimate dependence on claim 1 as presently amended. In view of the foregoing comments, Applicant respectfully submits that claims 2 to 5 and 9 are not anticipated by Habicht for at least the reasons provided above with respect to the subject matter of claim 1, and additionally in view of the additional subject matter recited by claims 2 to 5 and 9. Therefore, Applicant respectfully requests that the Examiner's anticipation rejection to claims 2 to 5 and 9 be withdrawn as well.

**Rejections under 35 U.S.C. § 103**

Claims 6, 7 and 13 stand rejected under 35 U.S.C. paragraph 103(a) as being unpatentable over Habicht in view of U.S. Patent No. 2,915,143 to Simmons. As previously indicated, Applicant has cancelled former claim 13. Therefore, Applicant respectfully submits that the Examiner's rejection of claim 13 under 35 U.S.C. § 103(a) has been rendered moot.

To establish a *prima facie* case of obviousness, M.P.E.P. paragraph 2142 and 2143 state that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. In *Re Vaeck*, 947 F. 2d 488, 20 USPQ 2d 1438 (Fed Circ 1991).

Claim 6 is dependent upon claim 5 and ultimately dependent upon amended claim 1. Applicant respectfully submits that the subject matter of claim 6 as incorporating the subject matter of claim 5 is not anticipated by Habicht. In particular, Habicht does not include "two rollers on opposite sides of the post" as recited in claim 5. In addition, the apparatus of Habicht does not include rollers which are "vertically offset from each other" as recited in claim 6. Simmons fails to correct this deficit of Habicht with regard to the subject matter of claim 6. The rollers of Simmons, as shown in Figures 2 and 3, do not include rollers on opposite sides of the post, but rather a roller on one side of the post and an opposing roller within the internal structure of the post.

Claim 7 includes the limitations that "each space member comprises a plate" and "whereby the storage portion exerts a force on the plates that tends to bias the offset rollers into engagement with the sides of the post". Simmons does not disclose a pair of spaced-apart plates but rather includes I-beams 32 which are joined by a horizontal

channel member 34 and two traverse I-beams 36 which extend underneath the platform. U-shaped brackets 40 are attached to the traverse channel member 34, and are used to rotatably mount rollers 42 as set out in column 2, lines 54 to column 3, line 1. The I-beams of Simmons do not support the rollers, but rather U-joints 40 support the rollers 42. Therefore, the I-beam of Simmons does not "tend to bias the offset rollers into engagement with the sides of the post". Rather, the bottom roller 48 is biased against the side of the post by the platform and the top roller 42 is biased against the interior of the post by U-joint 40.

In view of the foregoing comments, the Applicant suggests that the Examiner has failed to establish the *prima facie* obviousness of claims 6 and 7, for at least the reason that the cited references fail to disclose each and every element recited by the rejected claims. Therefore, the Applicant respectfully submits that the subject matter of claims 6 and 7 would not have been obvious to a person of ordinary skill in the art at the time the invention was made, and the Applicant respectfully requests that the rejection of claims 6 and 7 under 35 U.S.C. § 103(a) be withdrawn.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Habicht in view of U.S. design patent No. D473,377 to Chandaria. Chandaria discloses a design for a container for bulk packaging of fire logs and method of use. The container of Chandaria appears to be directed to packaging of logs and not for use as a container on a storage apparatus that is operable to be moved between a plurality of positions.

The container of Chandaria is not in a similar field or art to the container of Habicht for the reason that the container of Habicht is not a storage container, but rather a

container adapted to dispense a fluent material. Therefore, there is no teaching in either Habicht or Chandaria to combine these two references to provide the subject matter of claim 8. Accordingly, Applicant respectfully directs the Examiner's attention to MPEP § 2143.01 which states,

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990) ... Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' 916 F.2d at 682, 16 USPQ2d at 1432. See also *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992) ..."

In view of the foregoing comments, the Applicant suggests that the Examiner has failed to establish the *prima facie* obviousness of claim 8, as the Examiner has failed to provide a sufficient suggestion or motivation, in the prior art itself, for combining and/or modifying the references as suggested. Applicant respectfully submits that the subject matter of claim 8 therefore would not have been obvious to a person of ordinary skill in the art at the time the invention was made, as it would not have been obvious to combine Habicht with Chandaria. Applicant therefore respectfully requests that the objection of claim 8 under 35 U.S.C. § 103(a) be withdrawn.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Habicht in view of U.S. Patent No. 6,923,612 to Hansl. Hansl discloses a load-handling system and telescopic arm therefor transferring storage units into or out of a rack of a racking system by means of two spaced apart telescopic arms.

Hansl does not disclose “the rails are extendible from a stowed position below the storage portion to an extended position to receive support articles to be stored” as is recited in claim 10. Rather, Hansl discloses extendible telescoping arms that are used to move a container or an object from the load handling system into a rack to be stored. This is significantly distinct from the extending arms of claim 10 in that the arms of claim 10 are extended from underneath the container rather than moving the container into a storage rack. The rails of claim 10 when extended permit an additional storing surface in addition to the container to which they are mounted underneath. The telescoping arms of Hansl do not provide this benefit. In view of the foregoing comments, Applicant respectfully submits that a *prima facie* case of obviousness has not been established. Applicant therefore respectfully requests that the Examiner withdraw the obviousness objection of claim 10.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Habicht in view of U.S. Patent No. 4,421,209 to Vermette *et al.* Applicant has amended claim 12 to recite “the actuator mechanism comprises a chain hoist mounted to a support structure”. Support for the amendment is found generally in the specification as filed, and more particularly at page 3, line 20 to page 4, line 8; and at Figs. 1 and 2. As previously set out, Habicht does not disclose each and every element of claim 1 from which claim 12 depends. Applicant therefore respectfully submits that Vermette *et al.* fails to correct the defects of Habicht with regard to claim 1 as well as the additional subject matter of claim 12. In addition, neither of Habicht nor Vermetter discloses the use of a chain hoist as is currently recited in claim 12 as amended. Applicant therefore respectfully submits that

the Examiner has similarly failed to establish the *prima facie* obviousness of the subject matter of claim 12, and requests the withdrawal of the rejection of that claim under 35 U.S.C. § 103(a).

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 11-1540.

It is now believed that the subject patent application has been placed in condition for allowance, and such action is respectfully requested. If the Examiner has any questions or concerns, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned agent of record.

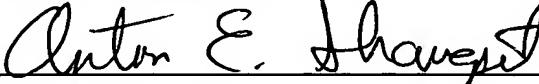
**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on December 22, 2005.

  
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Respectfully submitted,

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**Amendments to the Drawings:**

Please replace Figures 1 and 2 of the drawings with the attached replacement sheet.

The replacement sheet incorporates the desired changes to the drawings, and includes all of the figures that appeared on the immediately prior version of that sheet.

Attachment: one (1) Replacement Sheet